

REMARKS

Applicant respectfully acknowledges receipt of the Office Action mailed October 4, 2005.

In the Office Action, the Examiner (1) rejected claims 1, 2, 6, 7, and 57 under 35 U.S.C. § 102(b) as being anticipated by *Boxma* (U.S. Patent No. 5,721,623); (2) rejected claim 55 under 35 U.S.C. § 102(b) as being anticipated by *Pourjavid* (U.S. Patent No. 5,883,985); (3) rejected claims 3-5, 9-11, and 33-36 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Pourjavid*; (4) rejected claims 12-15 and 37 under 35 U.S.C. §103(a) as being unpatentable over *Boxma* in view of *Agano* (U.S. Patent No. 6,573,507); (5) rejected claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over *Boxma* in view of *Agano*, and further in view of *Pourjavid*; (6) rejected claims 19-21 under 35 U.S.C. §103(a) as being unpatentable over *Boxma* in view of *Ozaki* (U.S. Patent No. 5,896,202); (7) rejected claims 22-24 under 35 U.S.C. §103(a) as being unpatentable over *Boxma* in view of *Ozaki*, and further in view of *Pourjavid*; (8) rejected claim 56 under 35 U.S.C. §103(a) as being unpatentable over *Pourjavid*^{***}; (9) rejected claims 25, 26, and 28 under 35 U.S.C. §103(a) as being unpatentable over *Boxma* in view of *Pourjavid*; (10) rejected claim 27 under 35 U.S.C. §103(a) as being unpatentable over *Boxma* in view of *Pourjavid*, and further in view of *Agano*; (11) rejected claim 56 under 35 U.S.C. §103(a) as being unpatentable over *Pourjavid*; and (12) objected to claims 29 and 51 as being dependent upon a rejected

^{***} Applicant notes that the rejection of claim 56 on page 13, line 5, of the Office Action is repeated on page 14, line 20. Accordingly, Applicant believes there is a typographical error on page 13, line 5, and requests that the Examiner clarify this discrepancy.

base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this Amendment, Applicant amends the specification and claims 4, 6, 10, 14, 15, 17, 23, 27, 29, 35, 39-41, 45, 49, 53, and 54 to improve clarity and/or better define the claimed invention and cancels claims 55-57, without prejudice or disclaimer. After entry of this Amendment, claims 1-54 and 58 will remain pending. Of these claims, claim 1 is independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to the specification and claims 4, 6, 10, 14, 15, 17, 23, 27, 29, 35, 39-41, 45, 49, 53, and 54. No new matter has been introduced.

Applicant gratefully acknowledges the Examiner's indication of allowable subject matter in claims 29 and 51 if rewritten in independent form. However, Applicant has not rewritten claims 29 and 51 to include all of the limitations of the base claim and any intervening claims because at least independent claim 1, without any substantive amendments, is patentably distinguishable over the cited prior art.

Based on the foregoing amendments, Applicant traverses each of the above rejections and respectfully requests reconsideration for the reasons that follow.

I. 35 U.S.C. § 102(b) REJECTION

Applicant submits that independent claim 1 is patentably distinguishable under 35 U.S.C. §102 over the cited references, including *Boxma*, and the other art of record. The cited prior art fails to disclose or suggest each element of the invention recited in independent claim 1. In particular, the applied reference, taken alone or in combination, at least fails to teach or suggest an apparatus for printing a medical image on a

recording medium, comprising: a printing section to print either said medical image or a test-pattern for evaluating a quality of said medical image, on said recording medium, based on image data; a printing-condition setting section to set a printing condition for printing said test-pattern; and a printing-condition displaying section to display said printing condition set by said printing-condition setting section; wherein said printing section prints at least one of a sharpness-evaluating pattern and a granularity-evaluating pattern.

Applicant notes that in order to properly anticipate Applicant's claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th ed., 2001.

Boxma discloses a calibration method and device for adjusting a hard-copy-unit (HCU), wherein the HCU records medical images on a film. To correct for the deterioration of the image quality of the film, a hard copy of the film is made, with a number of predetermined grey values, and the resulting optical densities on the hard copy are measured. From the resulting optical density values, new brightness (B) and contrast (C) parameters are determined that will result in the correct maximum and minimum optical densities of subsequently exposed and processed images on the film (emphases added). (*Boxma*, Abstract and col. 2, ll. 23-27). *Boxma*, however, is silent as to improving image quality by producing test patterns for evaluating sharpness and granularity, as opposed to measuring density and determining brightness (B) and

contrast (C) parameters (emphases added). According to the present invention, “a conventional test pattern stored [for the]...image data in each...medical image recording apparatus is a density adjusting test pattern for correcting mainly look-up table (LUT) gradation characteristics. Though the gradation can be evaluated by this test pattern, the test pattern is not suitable for physical evaluation such as granularity and sharpness” (emphases added). (*Specification*, p. 4, ll. 12-18). Accordingly, *Boxma* necessarily fails to teach or suggest the claimed combination including *inter alia*: “a printing section to print either said medical image or a test-pattern for evaluating a quality of said medical image...wherein said printing section prints at least one of a sharpness-evaluating pattern and a granularity-evaluating pattern,” as recited in claim 1 (emphases added). For at least these reasons, Applicant requests that the rejection of claim 1 under 35 U.S.C. §102(b) be withdrawn and claim 1 be allowed.

Moreover, claims 2-54 and 58 are allowable at least due to their dependence from claim 1. In addition, at least some of the dependent claims recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

II. CONCLUSION

Applicant respectfully submits that independent claim 1 is in condition for allowance. In addition, claims 2-54 and 58 are in condition for allowance at least due to their dependence from independent claim 1.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 23, 2005

By: /David W. Hill/
David W. Hill
Reg. No. 28,220